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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,224	01/22/2004	Melvin Lee Jacobson	J274.12-0001	9161
164	7590	09/08/2006	EXAMINER	
KINNEY & LANGE, P.A. THE KINNEY & LANGE BUILDING 312 SOUTH THIRD STREET MINNEAPOLIS, MN 55415-1002			ROWAN, KURT C	
			ART UNIT	PAPER NUMBER
			3643	

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/764,224		JACOBSON, MELVIN LEE	
	Examiner		Art Unit	
	Kurt Rowan		3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 20, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-10,12-23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) 30-33 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-22 is/are allowed.
- 6) ☒ Claim(s) 1,5-10,12-18,23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 30-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the method could be performed by another and materially different product since the product could be used in a method such as one taking less than three minutes.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5, 6, 7, 12, 16-17, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. 2002/0112395 A1.

The Patent Application Publication '395 to Marsh shows an insect removal device 2 having an engagement surface (not labeled) covered with an adhesive layer 4, a

backing side (not labeled) positioned opposite the engagement side, and a single release tab 6 covered with a tab liner 10 as shown in Fig. 1. The tab extends from the top edge of the main body. Marsh shows the device for removal of a pest from a surface of a body of an animal or human. The main body is configured to conform to and attach to the surface to cover and smother the pest. Marsh shows the adhesive layer is composed of a material that is not irritating to human skin or animal skin. Marsh shows means such as the adhesive covered substrate for causing the pest to release from the surface since as shown in Fig. 4, the pest will be smothered by the adhesive which will cause the pest to release from the surrounding surface of a body. Marsh does not disclose that the pest removal device is placed on the skin of a body, but shows the device covering the pest at a point above the skin of a body. However, it would have been obvious that the device could be placed in contact with the skin of a body to obtain a more secure grasp of the pest by the adhesive. The release tab 6 of Marsh can be considered to be extending from an outer edge of the main body noting Fig. 1 since the tab does extend beyond the outer edge of the main body. In reference to claim 6, Marsh discloses that the adhesive layer is penetrated with an antiseptic in paragraph 16. In reference to claim 7, it would have been obvious to provide Marsh with alcohol which is an old and well known antiseptic. In reference to claim 12, Marsh shows a main body 2 having a length, a width, and an outer edge. Marsh shows the main body formed of a flexible resilient foam material as disclosed in page 1 paragraph numbered [0011]. Marsh shows an engagement side covered with an adhesive layer 4 and a backing side positioned opposite the engagement side. The

main body is substantially flat and shows the structure capable of being attachable to the surface by the adhesive layer to cover and smother the pest. Marsh shows a release tab 6 extending from (beyond) an outer edge as shown in Fig. 1. Marsh shows the release tab is graspable to apply a pulling force as shown in Fig. 4 to the center and hence to the outer edge of the main body to peel the main body off the surface. Marsh shows the release tab having a length parallel to the main body length in Fig. 1. Marsh does not disclose that the tab has a length less than the main body length and a width less than the main body width, but it would have been obvious to employ a tab with a length and width less than the main body width since the size of the tab would be determined through routine experimentation. See *In re Dailey et al.*, 147 USPQ 47. Marsh does not disclose the use of a hypoallergenic pressure sensitive adhesive, but states that the adhesive would be well known to one skilled in the art as stated on page 1 in paragraph numbered [0011]. Hence it would have been obvious to employ a hypoallergenic pressure sensitive adhesive. In reference to claim 23, Marsh shows a substrate having a first side and second side. Claim 23 further recites that the pest removal devices are attached to a storing liner and then may be boxed or packed in a resealable container. Marsh is silent on how the device is packaged, but it would have been obvious to store a plurality of devices together on a substrate or storing liner as is commonly done with many different medical products. Claim 23 recites a means for securing the pest to the first side of the substrate to completely surround and enclose the pest. Marsh also secures the pest to the first side of the substrate with an adhesive and completely surround and enclose the pest as shown in Fig. 4 which can be

considered to be at least an equivalent to the adhesive used by the present invention. Claim 23, recites a means for causing the pest to release itself from the surface which is taken to be an antiseptic solution. Marsh also discloses the pest releasing itself due to a pulling force by the user. Marsh also discloses the use of a suitable antiseptic or antibacterial substance impregnated into the adhesive layer which would tend to irritate the insect. Hence Marsh discloses the same release mechanism as recited since the present invention also pulls the insect from the surface. Claim 23 recites a means for holding the pest removal device without contacting the means for securing to permit the substrate to be peeled from the body surface with the pest secured which is taken to be the tab. Marsh shows a tab 6 which is taken to be an equivalent structure.

3. Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. '395 as applied to claim 1 above, and further in view of Grueling. The patent to Marsh shows a pest removal device as discussed above. The patent to Grueling shows a pest removal device for removing a pest from a surface having a main body with an engagement side 7, 8 covered with an adhesive layer 13, 14 as shown in Fig. 5. Grueling shows a backing side positioned opposite the engagement side and wherein the main body is configured to be applied to the surface to cover and smother the pest. Grueling shows a single release tab 11, 12 extending from an outer edge of the main body and covered with an adhesive layer 15, 16. In reference to claims 10 and 15, Grueling discloses an adhesive 4 on both sides of the main body 1 as shown in Fig. 2a.

6. Claims 8, 9, 13-14, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh as applied to claim 1 above, and further in view of Nelson '862.

The patents to Marsh and Nelson show insect capturing devices. Marsh has been discussed above and does not show the liner spooled in a dispenser. In reference to claims 8, 18, and 20, the patent to Nelson shows an insect capturing device with storing liner 50 as shown in Fig. 16. It would have been obvious to provide the pest capturing device of Marsh with a storage liner as shown by Nelson for the purpose of holding a plurality of capturing devices together during transport. In reference to claim 9, it would have been obvious to provide the insect capturing device of Marsh with a storing liner spooled on a dispenser shown in Fig. 9a of Nelson to conveniently carry more than one insect catcher at a time. In reference to claim 13, Nelson shows in Figs. 12-14 the main body having a length and width that are equal and define the diameter of a circle. In reference to claim 14, Nelson does not show a release tab in the shape of a half circle that extends from the perimeter of the main body. Nelson shows the main body having a smaller area of adhesive and the edge of the main body acts as a tab in both the rectangular and circular embodiments. Marsh does not disclose the shape of the tab. However, it would have been obvious to employ a semi-circular tab or a half circular tab since changes in shape are obvious noting that the function is the same. See *In re Dailey et al.*, 149 USPQ 47

Claims 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh in view Nelson.

4. The patents to Marsh and Nelson show insect capturing devices and have been discussed above. Marsh shows a material (as disclosed in paragraph 0016) incorporated into the adhesive to cause the pest to release from the surface. In reference to claim 24, it would have been obvious to provide the insect capturing device of Marsh and a storing liner as shown by Nelson In Fig. 16 to store a plurality of capture devices. Nelson shows a generally circular disk. The pest removal device of Nelson as shown in Fig. 5 contacts the body surface surrounding the pest and the pest removal device is substantially flat and flush with the body surface when in use to remove a pest. Also, column 6, lines 13-20. The patent to Marsh shows an insect removal device as discussed above. Marsh shows providing a pest removal device (as described above in reference to claim 23), positioning the engagement side completely over the pest (as shown by Marsh in Fig. 3), securing the pest removal device to the pest, pulling the single release tab, and removing the pest removal device with the pest attached to the engagement side of the pest removal device (as shown in Fig. 4). Marsh does not disclose attaching the pest removal device to the skin or the surface. The patent to Nelson shows attaching the pest removal device to the surface and the pest as shown in Fig. 5. In reference to claim 25, it would have been obvious to provide Marsh with the step of attaching the pest removal device to the pest and the surface as shown by Nelson for a time sufficient to cause the pest to release from the surface. Since March discloses an antiseptic, which will kill the pest in time, it appears that the pest would try to escape the antiseptic by releasing from the surface. In reference to claim 26, Nelson shows a storage liner 110. In reference to claim 27, both Nelson and Marsh

show folding the pest removal device to trap the pest. Nelson shows folding the pest removal device after peeling the device from the body surface to trap the pest as shown in Fig. 5 and Fig. 6. In reference to claim 28, Nelson discloses disposing of the pest removal device in column 7, lines 32-33. In reference to claim 29, neither Marsh or Nelson disclose saving the pest attached to the pest removal device and analyzing the pest for disease, but it would have been obvious to study the pest for disease to determine if more medical treatment is required.

Allowable Subject Matter

5. Claims 19-22 are allowed.

Response to Arguments

6. Applicant's arguments filed June 20, 2006 have been fully considered but they are not persuasive. Applicant argues that Marsh does not disclose a main body having a substantially uniform thickness with a release tab extending from a circumference of the main body. However, the tab of Marsh does extend from a circumference of the main body such as shown in Fig. 3, but not the same circumference as that of the present invention. Marsh when viewed as in Fig. 3 has a circumference going around the edge of the device as is shown in Fig. 3. However, the claim is not specific to which circumference is meant. Hence Marsh shows a single release tab extending from the circumference of the main body. As to the uniform thickness. It would have been obvious to employ a uniform thickness since changes in size and shape have been held to be obvious. See *In re Rose* 105 USPQ 137 and *In re Dailey et al.*, 149 USPQ 47.

In response to applicant's argument that Marsh and the present invention function in different manners as a result of different structure, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The claimed structure is the same as that shown by Marsh. Hence Marsh can perform the intended use in the manner recited by the present claims.

Marsh shows a single release tab that is graspable to applying a pulling force to the main body and peel the main body off of the surface starting with a portion of the main body closest to the release tab and finishing with a portion of the main body opposite the release tab. In reference to claim 12, Marsh does not disclose a generally circular pest removal device, but does form the device from a flexible resilient foam material. It would have been obvious to form the device in a generally circular shape since changes in shape have been held to be obvious noting that no stated problem has been solved. Also, see the arguments in regard to claim 1, above. Applicant's arguments with regard to claim 23 have been addressed in the above rejection. In regard to claim 24, applicant is relying on a section of Nelson that deals with the removal of an insect from a surface. Applicant is referred to column 6, lines 13-20 which discuss how Nelson specifically deals with the removal of an insect from the skin of a person. In reference to claim 25, Marsh shows the pest removal device formed from a flexible, resilient foam. It is not clear how close Marsh can be considered to have a uniform thickness, but clearly, the thickness is not substantially uniform. Nelson shows a pest removal device

having a uniform thickness. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art. Both patents show pest removal devices. Nelson shows a completely surrounded pest as shown in Fig. 5 and the device appears to be secured to the body surface since it is being laid across the back of a person's hand. Clearly the proposed combination contemplates that the pest will be surrounded for a sufficient time to release due to the antiseptic contained in Marsh.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is (571) 272-6893. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on (571) 272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kurt Rowan
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Art Unit 3643

KR